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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/338,729	06/23/1999	DENNIS GROSS	10853/I	1761

7590 05/19/2004

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EXAMINER

YU, GINA C

ART UNIT PAPER NUMBER

1617

DATE MAILED: 05/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/338,729

Applicant(s)

GROSS, DENNIS

Examiner

Gina C. Yu

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 March 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See continuation sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See continuation sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 10-73, 76-78, 85-89.

Claim(s) withdrawn from consideration: none.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
10. ☐ Other: _____


SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER

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Continuation from No. 2 & 5:

Applicants' arguments over telephone conferences and the written remarks filed after final have been fully considered, but examiner takes the position that the present invention is viewed as an art-recognized obvious variation of prior arts.

Examiner views that the main issue in this case is whether it would have been obvious to one of ordinary skill in the art at the time of the present invention to modify the prior art method of treating skin with the cosmetic mask compositions in Davis (US 5720 949) into the claimed method of treating skin with the applicants cosmetic liquid compositions. Specifically, the issue is whether it would have been obvious to the routineer to modify the sequential application of acidic cosmetic mask and effervescent (basic) cosmetic mask composition in any order as taught in Davis, into the claimed method of treating skin by sequentially applying first acidic cosmetic liquid composition followed by basic cosmetic liquid composition.

The prior art teaches and suggests that modification of one form of cosmetic regime to another is well known in the art. It is noted that the Davis reference teaches different regimes of cosmetic treatments in col. 1, lines 21 – 32, which states,

"[s]kin treatment regiments are well known and typically consist of applying a lotion or cream product periodically to the skin of the consumer. . . . The '544 patent discloses a cosmetic regimes consisting of the use of four components, namely, a cleanser, a cream, a lotion and a tonic. The prior art products of the lotion or cream type are generally massaged into the skin of the consumer. Accordingly they are not removed. Face masks are also available, generally referred to as "mud packs," that once applied to the surface of the skin harden to form a crustlike film, removable by soap and water." (emphasis added).

The reference thus teaches the specific method of how to use lotion or cream compositions, which would meet the applicants' method of using "liquid" limitations.

The method of sequentially applying an acid composition and then a base composition to obtain a neutralizing reaction on the skin is also taught in the Davis reference. The reference teaches that "the cosmetic mask product of the present inventions comprising the first and second compositions contains sufficient water to permit the aqueous phase reaction of the effervescent agent with the acid component.... [and] when applied to the skin to allow the aqueous phase reaction to take place in a cosmetically effective and safe manner." See col. 2, lines 1 – 4. The effervescent agent Davis used is sodium bicarbonate, which is the neutralizing agent in the present invention. Davis also teaches using alpha-hydroxy acids such as lactic, citric, malic, glycolic acid. See col. 9, lines 8 – 13. The reference specifically teaches that salicylic acid, a beta-hydroxy acid, is also preferred due to its anti-acne properties. See *Id.* Davis particularly prefers lactic acid. See *Id.*

While applicants assert that Davis fails to teach all the elements of the compositions used in the invention, examiner advises that Davis teaches using cosmetically useful adjuvants such as emollients, counterirritants, astringents, cleansing agents, biocides and anti-acne agents "in an amount effective to provide its intended benefits when applied to the skin of the consumer". See col. 1, lines 50 – 59. The reference goes on to teach adding emulsifying agents, emulsion stabilizers, hydrotropes, thickeners, binder, pH adjusting agents, chelating agents, and preservatives. See col. 1, lines 60-67. The recited components in the first composition,

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i.e., chelating agent, witch hazel distillate (astringent), surfactant/emulsifying agent, glycolic acid, ammonia, preservative, and acetone and alcohol, which are organic solvent, and water. While applicants assert that Davis fails to teach all the elements of the compositions used in the invention, examiner advises that Davis teaches using cosmetically useful adjuvants such as emollients, counterirritants, astringents, cleansing agents, biocides and anti-acne agents "in an amount effective to provide its intended benefits when applied to the skin of the consumer". See col. 1, lines 50 – 59. The reference goes on to teach adding emulsifying agents, emulsion stabilizers, hydrotropes, thickeners, binder, pH adjusting agents, chelating agents, preservatives, and organic solvents. See col. 3, lines 11 - 30. The recited components in applicants' first composition, i.e., chelating agent, witch hazel distillate (astringent), surfactant/emulsifying agent, glycolic acid, ammonia, preservative, and acetone and alcohol (organic co-solvents), and water. The second composition in instant claim 10 reads on a composition comprising 0.1 % by weight of sodium bicarbonate, 0.1 % of a surfactant and water. Example 1 shows that the composition comprises cetyl alcohol, a surfactant. Davis teaches a skilled artisan to add, in the cream mask composition containing effervescent agent, skin conditioning adjuvants such as antioxidants such as tocopherol acetate (vitamin E) and a chelating agent. See col. 8, lines 14 – 49. Using witch hazel as an astringent, trisodium EDTA, methyl paraben, and imidiazolidinyl urea in a cosmetic composition is generally taught, and examiner views that it would have been obvious to a skilled artisan to employ these conventional cosmetic adjuvants to either first or second composition of the instant invention. See col. 8, lines 36 – 50.

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The reference only teaches against using salicylic acid in the same composition comprising the effervescent agent. For the remaining elements not addressed in Davis, such as green tea extracts, vitamin A, polysorbate 21 and octoxynol-9, are taught in secondary references Hahn (US 2002/0098210), Linn et al. (US 4793273). Further search may be required to find publications showing the remaining ingredients are conventionally used in cosmetic arts.

While applicants argue that the claimed sequential order is not taught in the reference, examiner respectfully disagrees. Davis teaches that moisturizing cream pretreatment composition is "gently massaged into the skin and left in skin for a predetermined period of time" to provide a gentle exfoliation of the skin, which also meets the method step of the first application acidic composition to skin. See col. 10, lines 1-6. The reference teaches that when alpha- and beta- hydroxy acids are present in the moisturizing cream pretreatment compositions, the composition is buffered by using ammonium. See col. 10, lines 1-30. While the reference teaches that the application of the effervescent composition first followed by the acidic composition is preferred, the reference goes on to say that the order of application "may be reversed if longer contact between the acid component and the skin is desired to enhance exfoliation of the skin, especially in the absence of pretreatment with a moisturizing cream that contains an exfoliant". See col. 10, lines 44-51. Thus, it is clear that the Davis reference provides one of ordinary skill in the art ample motivation to first apply either the moisturizing cream pretreatment composition or the acidic composition of the Davis in order to obtain **enhanced exfoliation of the skin**.

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In response to applicants' arguments that Davis requires certain viscosity of the compositions, examiner respectfully points out that a modification of one form of cosmetic composition to another, such as from mask to liquid as in this case, is an art-recognized variation of one cosmetic regime to another. It is noted that the reference teaches the second composition is in "the form of a composition that does not flow appreciably when applied to the skin", and that it even may be "anhydrous". See col. 3, lines 40 – 60. However, the difference in viscosities of the prior art compositions and the present compositions, or the difference in the form of the compositions, is not viewed as a patentable distinction, but merely a result of the modification of the prior art cosmetic regime to another well known form of cosmetic method.

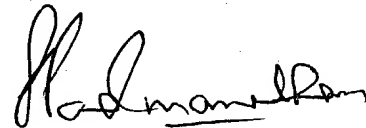
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-0635. The examiner can normally be reached on Monday through Friday, from 8:30 AM until 6:00 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina Yu
Patent Examiner



**SREENI PADMANABHAN
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